

REMARKS

New claim 49 has been added requiring the presence of “a ratio by mass of the non-volatile silicone compound relative to the non-volatile hydrocarbon-based oil is greater than or equal to 1.” Support for this new claim exists throughout the present specification.

Claims 1-49 are currently pending.

The Office Action rejected claims 1-48 under 35 U.S.C. § 103 as obvious over U.S. patent 5,948,394 (“Walling”) in view of U.S. patent 5,093,043 (“Jakobson”) and further in view of U.S. patent 5,093,043 (“Arnaud”). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The claimed invention requires the presence of a specified non-volatile hydrocarbon oil having specified solubility characteristics, a non-volatile silicone oil and a volatile hydrocarbon oil which is incompatible with the silicone oil. Also, the claimed invention requires the presence of specified amounts of silicone oil and/or specific ratios of silicone oil to hydrocarbon oil. This unique combination of ingredients having the specified properties and relationships results in novel glossy, transfer-resistant products. The cited art neither teaches nor suggests such products.

Walling generally discloses combining several different types of oils and waxes to form lipstick products. However, Walling completely fails to teach, suggest or recognize the importance of combining compounds having all of the specified properties and relationships required in the claims: that is, Walling could not possibly lead one skilled in the art to combine a hydrocarbon-based oil and a non-volatile silicone compound which are

both soluble/dispersible in a volatile hydrocarbon-based solvent yet incompatible with each other in the required amounts/ratios. Walling contains no guidance whatsoever to make such a unique combination.

It would not merely have been a matter of “optimization” of Walling’s disclosure to choose all of the required ingredients, properties and relationships in the invention compositions from Walling’s general disclosure to arrive at the claimed invention. Rather, it would have necessitated a wholesale re-writing of Walling’s disclosure. Such informed choices could only have been made with hindsight, using the present application as a guide. In other words, nothing in Walling would have motivated one skilled in the art to combine the required ingredients in the required manner to arrive at the claimed invention. It is only through the present application that the invention compositions can be produced.

For example, Walling fails to expressly teach “the particular percentages of each ingredient.” (Office Action at page 3). Given this fatal deficiency, Walling could not possibly motivate one skilled in the art to combine the required ingredients in the required amounts/ratios.

Moreover, Walling fails to teach, suggest or recognize the importance of including oils having the required solubility parameters. Thus, Walling fails to recognize that the required solubility parameters are significant parameters which must be satisfied, meaning that no motivation would or could have existed to “optimize” these parameters and no teaching or suggestion to include oils having the required solubility parameters would have existed.

Furthermore, with respect to new claim 49, Walling neither teaches, suggests or recognizes the importance of having more non-volatile silicone compound present than non-volatile hydrocarbon-based oil.

Walling's teaching is so general, disclosing over the span of two and a half columns that any oil can be combined with any other oil, that it provides no guidance whatsoever concerning which oils and waxes could be advantageously combined, let alone the specific concentrations and ratios in which to combine the oils and waxes. As a matter of law, such a general disclosure relating to the theoretical combination of any amount of hundreds or thousands of cosmetic ingredients cannot anticipate or render obvious the specific subject matter of the presently claimed invention. *See, In re Meyer*, 599 F.2d 1026 (CCPA 1979); *Akzo v. International Trade Comm'n*, 808 F.2d 1471 (Fed. Cir. 1986).

Clearly, Walling neither teaches nor suggests the claimed invention, and one skilled in the art following Walling's disclosure would not be led to the present invention.

Jakobson and Arnaud do not compensate for Walling's deficiencies. Jakobson is cited only for its disclosure related to diglyceryl diisostearate, and Arnaud is not cited for any reason. Neither reference teaches, suggests, or recognizes the importance of combining a hydrocarbon-based oil and a non-volatile silicone compound which are both soluble/dispersible in a volatile hydrocarbon-based solvent yet incompatible with each other in the claimed amounts/ratios.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection.

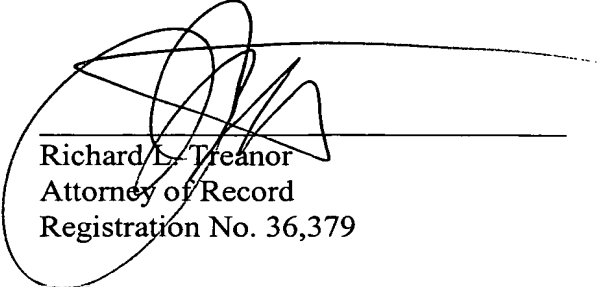
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Applicant believes that the present application is in condition for allowance.

Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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